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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _8/28/02_ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-25_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-25_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a)..

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

  If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

  a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: request for reconsideration filed on

8/28/02 to the application filed on 12/29/98.

2.   Claims 1-25 are pending in the case. Claims 1-3, 16, 20-22, 25 are independent

claims.

3.   The objection of claim 15 as including a typographical error has been withdrawn

in view of the amendment of claim 15.

4.   The obviousness type double patenting rejection of claim 3 as being a substantial

duplicate of claim 2 has been withdrawn in view of applicants' argument.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States
> before the invention by the applicant for patent, except that an international application filed under the
> treaty defined in section 351(a) shall have the effect under this subsection of a national application
> published under section 122(b) only if the international application designating the United States was
> published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the
> invention by the applicant for patent, except that a patent shall not be deemed filed in the United
> States for the purposes of this subsection based on the filing of an international application filed under
> the treaty defined in section 351(a).

6.   Claims 1-7, 16, 20-23, 25 remain rejected under 35 U.S.C. 102(e) as being

anticipated by Markowitz et al. (US Pat No. 6,311,185 B1, 10/20/01, filed 10/30/97).

Regarding independent claim 1, Markowitz discloses:

- automatically determining a content data of the given information unit (col 1, lines
  32-42, "...displaying advertisement on their Web pages...including an
  advertisement in the *original HTML data that defines a Web page...* a Web page
  containing travel tips ...could include... a hotel advertisement"; the fact that an
  advertisement is included directly in a Web page <u>based on the data or the</u>
  <u>content of the Web page</u> shows that the content data of a web page is
  determined automatically by the content provider; col 2, lines 60-64, the fact that
  the ISP can obtain the HTML data related to the web page from the Internet
  whenever a user requests a web page to be displayed on his browser inherently
  shows that the content data of the web page and also the content data of the
  advertisement are automatically determined by the system without any user
  intervention to decide which HTML data from the Internet is related to the web
  page; col 3, line 60 to col 4, lines 1-19, the fact that a software architecture is
  used to perform the process of selecting an appropriate advertisement for linking
  to a web page inherently shows that the steps of the selecting process including
  determining the web page to select a related advertisement are carried out
  automatically since the software is implemented by a program where the steps
  are done automatically as defined)
- automatically selecting the chosen information unit as a function of the content
  data of the given information unit(col 2, lines 60 to col 3, lines 1-18,... the Web

page currently being requested can similarly be used to select an appropriate

advertisement...; the *chosen* information unit is considered as a *candidate*

information unit since it is *selected* unit, and as in the abstract, the candidate

information unit is an advertisement, therefore, the chosen information unit is an

advertisement *selected as a candidate information unit* related to the content of a

Web page)

Regarding independent claim 2, Markowitz discloses:

- determining a content data of the candidate information unit (col 1, lines 32-42;

  col 2, lines 60 to col 3, lines 1-18, the fact that an appropriate advertisement is

  selected to be included in a web page shows that the content data of an

  advertisement, which is a candidate information unit as explained in the abstract,

  is determined)

- automatically determining a content data of the given information unit (col 1, lines

  32-42; col 2, lines 60 to col 3, lines 1-18, the fact that an appropriate

  advertisement is selected to be included in a web page shows that the content

  data of the web page, which is a given information unit, *is automatically*

  determined by the content provider to find out which HTML data is related to the

  web page)

- comparing the content data of the given information unit to the content data of

  the candidate information unit (col 1, lines 32-42; col 2, lines 60 to col 3, lines 1-

  18, the fact that an appropriate advertisement is selected to be included in a Web

page inherently shows that the content data of the candidate information unit, which is an advertisement, and the content data of the given information unit, which is a web page as explained in the abstract, *are compared* to see if the two are related to make an appropriate selection)

- selecting the candidate information unit for linking to the given information unit as a function of said step of comparing the content data of the given information unit to the content data of the candidate information unit (col 1, lines 32-42; col 2, lines 60 to col 3, lines 1-18)

Regarding to independent claim 3, claim 3 includes all the limitations of claim 2 and so is rejected under the same rationale, except in claim 3 the *step comparing is carried out automatically.*

Since Markowitz discloses a software architecture for performing the process of selecting an appropriate advertisement for linking to a web page (col 2, line 60 to col 3, lines 1-19), where the steps included in the process are done according to the program of the software, Markowitz inherently discloses that the steps are done automatically without any user intervention.

Regarding claims 4 and 7, which are dependent on claims 3 and 4 respectively, Markowitz discloses placing the candidate information unit in *a look-up tree* according to the content data of the candidate information (figure 3, #320 database look-up and #330 select advertisement from database imply that the candidate information unit, which is

an advertisement, is placed in a *look-up database* according to the content data of the

candidate information so that an related advertisement to a web page can be selected

to incorporate to the web page; in addition, it was well known that any database is

organized *in a hierarchy format, or a tree format*). The given information unit is a Web

page (as defined in the abstract), and therefore, it is available on the Internet.

Regarding claim 5, which is dependent on claim 4, Markowitz discloses that

automatically comparing the content data of the given information unit to the content

data of the candidate information unit comprises traversing the look-up tree (figure 3,

#320 database lookup and #330 select advertisement from database, show the

traversing the look-up tree since a database is organized as a tree structure, and lookup

a database implies traversing that database; col 4, lines 7-18, the advertisement

selected from database that relates to a web page shows that the content of the

advertisement and the content of the web page are compared to find out their

relationship).

Regarding claim 6, which is dependent on claim 4, Markowitz discloses that the

structure of the look-up tree includes the content data of the candidate information

(figure 3, #320, #330; col 4, lines 7-18, the database should include the content data of

the candidate information so that the comparing is performed to select advertisement

from the database).

Regarding independent 16, Markowitz discloses:

- automatically determining a user computer system data (col 1, lines 32-42; col 2,

    lines 60 to col 3, lines 1-29, a web page, which is a user computer system data,

    is determined to select a related advertisement; figure 1, col 3, line 60 to col 4,

    lines 1-19, the fact that a software architecture is used for the process of

    selecting an appropriate advertisement for linking to a web page inherently

    shows that the steps of the process including determining the web page to select

    a related advertisement are carried out automatically since the software is

    implemented by a program where the steps are done automatically as defined)

- selecting a chosen information unit as a function of the user computer system

    data (col 1, lines 32-42; col 2, lines 60 to col 3, lines 1-18; figure 3, #320-#340

    selecting an appropriate advertisement to incorporate to a web page)

Independent claims 20-22 are for a storage medium of method claims 1-3, and

therefore are rejected under the same rationale.

Regarding claim 23, which is dependent on claim 4, Markowitz discloses that the

candidate information unit includes an advertisement to be displayed to a user (col 1,

lines 32-42; col 2, lines 60 to col 3, lines 1-18 as mentioned in claims 1-3).

Regarding independent claim 25, Markowitz discloses:

- a server (figure 3, #200; col 2, lines 59-60, server 200)

- a given information unit (figure 3, #600 ISP; col 1, lines 43-51, the content

  provider such as an Internet Service Provider ISP provides the contents of the

  web pages)

- a candidate information unit coupled to said server and given information unit

  (figure 3, # 200 server, #600 ISP and #214 repository database including

  advertisements are connected together; col 2, lines 65 to col 3, lines 1-18)

where the server adapted to:

- determine a content data of the candidate information unit (col 1, lines 32-42; col

  2, lines 60 to col 3, lines 1-18, the fact that an appropriate advertisement is

  selected to be included in a Web page shows that the content data of an

  advertisement, which is a candidate information unit as explained in the abstract,

  is determined)

- automatically determine a content data of the given information unit (col 1, lines

  32-42; col 2, lines 60 to col 3, lines 1-18, the fact that an appropriate

  advertisement is selected to be included in a Web page shows that the content

  data of a Web page, which is a given information unit as explained in the

  abstract, *is also determined* to find out the relationship between a web page and

  an related advertisement)

- automatically compare the content data of the given information unit to the

  content data of the candidate information unit to create a comparison result (col

  1, lines 32-42; col 2, lines 60 to col 3, lines 1-18, the fact that an appropriate

  advertisement is selected to be included in a Web page shows the result of the

comparison between the content data of the candidate information unit, which is

an advertisement, and the content data of the given information unit, which is a

given information unit as explained in the abstract, because the two include

related data)

- link the candidate information to the given information unit as a function of the

comparison result (col 1, lines 32-42; col 2, lines 60 to col 3, lines 1-18)

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

9.   Claims 8-9, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Markowitz et al. (US Pat No. 6,311, 185 B1, 10/30/01, filed 10/30/97).

Regarding claim 8, which is dependent on claim 3, Markowitz does not disclose that

determining the content data of the candidate information unit includes:

- collecting the content data of the candidate information unit

- incorporating the content data into the candidate information unit

- storing the candidate information unit and the content data of the candidate

   information unit

Instead Markowitz discloses storing advertisements in the database for lookup and for

selecting (figure 3, #320 and #330).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have modified Markowitz to include collecting the content data of the

candidate information unit and incorporating the content data into the candidate

information unit since the step storing of the candidate information unit suggests that the

candidate information unit should be created including the content data of the candidate

information first.

Regarding claim 9, which is dependent on claim 3, Markowitz does not disclose that

determining the content data of the candidate information unit includes:

- collecting the content data of the candidate information unit

- linking the content data into the candidate information unit

-   storing the candidate information unit and the content data of the candidate

    information unit

The difference between claims 8 and 9 is that instead of using the word "incorporating"

as in claim 8, the word "linking" is used in claim 9.

Since "linking the content data to the candidate information unit" has the same meaning

as "incorporating the content data to the candidate information unit" where the content

data is included to the candidate information unit, claim 9 discloses the same subject

matter as in claim 8.

Claim 9, therefore, is rejected under the same rationale.

Regarding claim 24, which is dependent on claim 4, Markowitz does not explicitly

disclose that the look-up tree includes at least one folder and at least one sub-folder.

However, it was well known that any database is organized in a hierarchy structure or a

tree structure.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to have modified Markowitz to include at least one folder and at

least one sub-folder in the database since the hierarchy structure of the database in

Markowitz suggests a structure of multiple folders of different levels.

10.   Claims 10-15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Markowitz as applied to claim 3 above, and further in view of Yu (US Pat No.

6,067,552, 5/23/00, filed 3/30/98, priority 8/21/95).

Regarding claim 10, which is dependent on claim 3, Markowitz does not disclose:

-   searching the given information unit

-   indexing the given information unit to produce an indexed data

-   performing a relevancy ranking on the indexed data

Yu discloses:

-   searching the given information unit (col 4, lines 11-15, *traverse a hypertext
    database* ...)

-   indexing the given information unit to produce an indexed data (col 4, lines 15-
    22, storing an index in association with the hypertext database, the index
    comprising...)

-   performing a relevancy ranking on the indexed data (col 4, lines 22-51, receiving
    a set of relevant index term values....comparing ..using the weighted relevancy
    ranking... producing a list of electronic documents... based on the relevancy
    ranking...)

It would have been obvious to one of ordinary skill in the art at the time of the invention
was made to have combined Yu into Markowitz to facilitate the searching of the web
page database using the web page indexing for a related advertisement.

Claim 11 includes the same subject matter as in claim 10, and is rejected under the
same rationale.

Regarding claims 12 and 13-14, which are dependent on claims 10 and 11 respectively, Markowitz discloses that the given information is available on the Internet, the given information includes a page of content on the World Wide Web, and the candidate information unit includes an advertisement to be displayed to a user (col 1, lines 32-42, col 2, lines 60 to col 3, lines 1-18, the given information is a web page, so it is available on the Internet, the related advertisement to a web page is displayed to a user).

Regarding claim 15, which is dependent on claim 3, Markowitz does not disclose that determining a content data of the given information unit further includes:

- selecting a keyword

- counting a number of occurrences of the key word

- ranking the key word according to the number of occurrences of the keyword

Yu discloses:

- counting a number of occurrences of the key word (col 3, lines 43-58, ...the number of times a keyword appears in the content of the document....)

- ranking the key word according to the number of occurrences of the keyword (col 4, lines 23-63, ...setting a weighted relevancy ranking of each descriptive index term...)

Yu does not disclose explicitly selecting a keyword. However, the counting of a number of occurrences of the keyword in Yu shows that the keyword is selected for occurrence counting.

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Yu into Markowitz for fast rendering the related data from

a database using the ranking of keywords in a document.

Regarding claim 17, which is dependent on claim 12, Markowitz discloses:

- accessing a user computer system through a user Internet connection (figure 1)

- querying the user computer system to determine a user computer system data

  (col 2, lines 60-64, a user at the PC 500 requests a Web page)

- returning the computer system data through the user Internet connection (col 2,

  lines 60-64, a requested web page from the Internet is displayed to a user)

Regarding claim 18, which is dependent on claim 3, Markowitz discloses that the given

information unit includes a user-input information (col 2, lines 60-64, since a user has to

make a request for a web page, the user has to input some information relating to a web

page in the request).

Regarding claim 19, which is dependent on claim 14, Markowitz discloses:

- obtaining a user-input information (col 2, lines 60-64, the user input information

  for a web page is obtained in the user request)

Markowitz does not disclose incorporating the user-input information into the content

data of the given information unit. Instead Markowitz discloses that once a user request

for a web page is sent to the Internet Service Provider ISP, the ISP can obtain the

HTML data related to the web page from the Internet (col 2, lines 60-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have modified Markowitz to include incorporating the user-input

information into the content data of the given information unit. The fact that the ISP can

obtain the HTML data related to the web page from the Internet suggests that the user-

input information, which is actually the keyword in the request, is included in the web

page, the given information.

Response to Arguments

11.   Applicant's arguments filed 8/28/02 have been fully considered but they are not

persuasive.

Regarding claims 1-7, 16, 20-23, and 25, Applicants argue that Markowitz (col 2, lines

60-64) as cited or anywhere else in Markowitz fails to teach or suggest automatically

determining a content data of the given information unit (e.g. web page).

Examiner disagrees.

In Markowitz (col 2, lines 60-64), the fact that the Internet Service Provider (**ISP**) **can**

obtain the HTML data related to the web page from the Internet whenever a user

requests a web page to be displayed on his browser inherently shows that the **content**

data of the web page and also the content data of the advertisement are

automatically determined by the system to decide which HTML data from the Internet

is related to the web page. Also, it is easy to recognize that obtaining the HTML data

related to the web page in the ISP is carried out without any user intervention. This

suggests that the content of the web page be automatically determined to see if the

content of the web page and the HTML data match.

Markowitz also discloses determining the specific attributes of the web page to select

what the appropriate advertisement to be added to the web page (col 3, lines 29-37, "...

the server can determine the specific attributes of the web page ...and decide how the

selected advertisement can best be added; col 3, line 60 to col 4, lines 1-19, "an

appropriate advertisement is selected... *based on the attributes of the Web page...*"

shows that the attributes of the web page is determined for an appropriate

advertisement selection). Markowitz further discloses that the process of determining

the content of the web page and selecting an associated advertisement to the web page

is done using a software architecture (col 3, line 60 to col 4, lines 1-19). *This inherently*

shows that the process of said determining and said selecting are done automatically

since it was well known that any software is implemented by a computer program where

the specified steps are performed automatically in the program.

Claims 8-9, 24 are rejected as being dependent on claims 3 and 4 which are rejected

above.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 707-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

9000.

clh
11/7/02

HEATHER R. HERNDON
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